

amendment is found, by way of example and not by limitation, at page 7, line 6, of the Specification. The temperature of 480°C is recited as being deemed optimum for integrated circuit manufacture, and the range of about 480°C to 700°C is inherently subsumed in the range of 200°C to 700°C recited by the Specification.

The rejection has put forth the argument that Hisamune teaches a deposition temperature of about 400°C, to which Applicant respectfully objects. Hisamune recites various temperatures, but Applicant is unable to find a recitation of about 400°C as asserted by the rejection. *See, e.g.*, Hisamune, page 2, line 28 (“a temperature of 200-400°C”); page 3, line 31 (“at a low temperature of less than 400°C”); page 3, line 33 (“at a low temperature of less than 400°C”); and page 3, line 34 (“a temperature of 300°C”). In contrast to the assertions of the rejection, Applicant respectfully submits that Hisamune appears to recite a maximum temperature of 400°C. Accordingly, Applicant respectfully submits that Hisamune cannot anticipate Applicant’s recitation of a temperature of about 480°C to 700°C, and appears to teach away from such a range.

In view of the above, Applicant respectfully submits that claims 31 and 42 are patentably distinct from the cited reference. As claims 33, 34, 36, 39 and 40 depend from and further define patentably distinct claim 31, these claims are also believed to be allowable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claims 31, 33, 34, 36, 39, 40 and 42.

Claims 32, 51 and 52

Claims 32, 51 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hisamune (JP 2-050966) as applied to claim 31 above, and further in view of McDowell et al. (U.S. Patent No. 4,287,083).

In view of the amendment to claim 31 discussed *supra*, Applicant respectfully submits that claim 31 is patentably distinct from the primary reference, Hisamune. Applicant further respectfully submits that McDowell et al. as a secondary reference is unable to overcome the deficiencies of the primary reference. As claim 32 depends from and further defines patentably distinct claim 31, this claim is also believed to be allowable.

Claims 51 and 52 have been amended to recite heating the substrate surface to a temperature of about 480°C to 700°C. Applicant thus respectfully submits that claims 51 and 52 are patentably distinct from the primary reference, Hisamune, for the reasoning as applied to claim 31. Applicant further respectfully submits that McDowell et al. as a secondary reference is unable to overcome the deficiencies of the primary reference.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claims 32, 51 and 52.

Claims 35, 37 and 38

Claims 35, 37 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hisamune (JP 2-050966) as applied to claim 31 above, and further in view of Wang et al. (U.S. Patent No. 5,000,113).

In view of the amendment to claim 31 discussed *supra*, Applicant respectfully submits that claim 31 is patentably distinct from the primary reference, Hisamune. Applicant further respectfully submits that Wang et al. as a secondary reference is unable to overcome the deficiencies of the primary reference. As claims 35, 37 and 38 depend from and further define patentably distinct claim 31, these claims are also believed to be allowable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claims 35, 37 and 38.

Claims 1, 2, 4-10, 41, 43-50

Claims 1, 2, 4-10, 41, 43-50 were rejected under 35 U.S.C. § 103(a) as obvious over Hisamune (JP 2-050966) in view of Imai et al. (U.S. Patent No. 5,633,211).

Imai et al. Priority Date

The Imai et al. patent issued May 27, 1997 claiming an effective U.S. filing date of March 26, 1993. Since Imai et al. issued after the filing date of the present application (i.e., April 22, 1996), Imai et al. may be properly defined as a reference under 35 U.S.C. § 102(e). Since Imai et al. may be a reference defined under 35 U.S.C. § 102(e), it is a removable reference

if Applicant proves a date of invention predating March 26, 1993 (the effective filing date of the Imai et al. patent). Applicant respectfully reserves the right to file a Petition under 37 C.F.R. § 1.131 to swear behind the Imai et al. patent. However, because Applicant deems Imai et al. to be distinguishable from the instant claims, Applicant at this time does not choose to remove Imai et al. as a reference, but reserves exercising this right for a later date.

Rebuttal of the Rejection

Applicant respectfully submits that it is improper to combine Imai et al. with Hisamune. It is apparent from Hisamune that photo-CVD was understood in the art at the time of the earliest priority date claimed by Imai et al. *See* Translation of Hisamune, page 2, lines 7-13; Imai et al., Front Page, section 30. Yet Imai et al. specifically recites conventional CVD in conjunction with the source compounds relied upon by the rejection. Imai et al., column 1, lines 42-46 and Table. Given Imai et al.'s specific designation of conventional CVD for use with the source compounds, Applicant respectfully submits that there is no motivation to combine Imai et al. with Hisamune and its photo-CVD process. Applicant further respectfully submits that Imai et al.'s designation of conventional CVD teaches away from the use of other CVD processes in conjunction with its disclosure.

Accordingly, Applicant respectfully submits that it is improper to combine the references in a manner necessary to support rejection of claims 1, 2, 4-10, 41 and 43-50. Applicant respectfully submits that there is no teaching or suggestion to combine the references absent Applicant's own disclosure. Accordingly, Applicant respectfully submits that the rejection of claims 1, 2, 4-10, 41 and 43-50 is unsupported. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claims 1, 2, 4-10, 41 and 43-50.

Claims 53 and 54

Claims 53 and 54 were rejected under 35 U.S.C. § 103(a) as obvious over Hisamune (JP 2-050966) in view of Imai et al. (U.S. Patent No. 5,633,211), and further in view of McDowell et al. (U.S. Patent No. 4,287,083).

As discussed *supra*, Applicant respectfully submits that it is improper to combine Imai et al. as a secondary reference with Hisamune as a primary reference. The tertiary reference of McDowell et al. is unable to overcome this deficiency. Applicant thus respectfully submits that the rejection of claims 53 and 54 is unsupported. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claims 53 and 54.

CONCLUSION

Claims 31, 42, 51 and 52 are amended herein. Claims 1, 2, 4-10 and 31-54 are pending.

Applicant believes the claims are in condition for allowance and requests reconsideration of the application and allowance of the claims. The Examiner is invited to telephone Applicant's representative at 612-371-2103 to discuss any questions which may remain with respect to the present application.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231 on Sept 7, 1999.

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